

Remarks**Introduction**

Claims 1-228 were previously canceled.

Claims 229-246 were presented and rejected.

Claim 238 is amended to correct a potential antecedent basis issue.

New claims 247-249 are added to provide alternate claim formats for claims 229 and 238.

Applicant hereby respectfully requests reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

The Office Action's Rejections**35 U.S.C. § 112**

Claims 229-237 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Specifically, the use of the term “second information provider” is alleged to be new matter. Applicant respectfully traverses.

“The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” MPEP § 2163.02. Rather,

[a]n objective standard for determining compliance with the written description requirement is, “does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.” *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Ibid.

To the extent that the term “information provider” is not used in the specification, Applicant is allowed to use functional language in the claims. The drawings and specification

clearly outline a three-way relationship between the broadcaster, an entity named “Impulse Radio” and the listener. The entity named Impulse Radio provides information to the broadcaster, and thus, is functionally an information provider. With that example before them, someone of ordinary skill in the art has no trouble understanding what is meant by information provider.

In view of this explanation and the fact that the information provider is not new matter, Applicant requests withdrawal of the § 112, first paragraph rejection at this time.

Claims 229-237 were rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to particularly point out and distinctly claim the subject matter of the invention. Specifically, the term “broadcast content” is alleged to be indefinite. Applicant respectfully traverses. The MPEP sets forth the underlying test for whether claim language is sufficiently definite.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

MPEP § 2173.02. As noted in the Office Action, the term “broadcast content” is used in the specification, although it is not specifically defined. “[A] claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible.” *Ibid.* Likewise, the Patent Office routinely interprets terms not defined in the specification by using the broadest reasonable interpretation. MPEP § 2111. Breadth alone is not a reason to make the claim term indefinite. MPEP § 2173.04. This broadest reasonable interpretation should be based on the plain meaning of the term unless otherwise defined in the specification.

Here, the specification discusses at length what is contained in the broadcast, and how it is associated with supplemental information. Even applying a simple, ordinary definition (i.e., the plain meaning of the term, albeit, the broadest reasonable interpretation thereof) to the term, the reader is left understanding that the term broadcast content means the content of the broadcast. Likewise, one possessing ordinary skill in the art would, after reading the specification, understand the contextual meaning of broadcast content to be the content of the

broadcast. Since the meaning is apparent to one of ordinary skill in the art, no indefiniteness is present.

The lack of indefiniteness is further highlighted by the Patent Office's ability to provide a suitable definition for the term in paragraph 11 of the Office Action of 26 June 2010, where the Patent Office equates "broadcast content" with "broadcast data".

Since the claims are not indefinite, Applicant requests withdrawal of the § 112, second paragraph rejection at this time.

Claims 229-239 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Particularly, the term "supplemental information" is alleged to be indefinite. Applicant respectfully traverses. The standard for indefiniteness is set forth above.

As noted above, just because a claim term is not defined in the specification does not mean that the claim term is indefinite if the meaning of the claim term is discernable. Here, the plain meaning (albeit, the broadest reasonable interpretation thereof) suffices to make the claim term definite. That is, the claim recites "supplemental information". The information is used in association with the broadcast data. The intended meaning of the claim is further clarified by the rest of the claim "receiving from the second information provider supplemental information associated with the data relating to the future broadcast. . . ." So the information is associated with the data relating to the future broadcast, and supplements the future broadcast.

Contextually, there is no indefiniteness associated with the claim. Applicant requests withdrawal of the § 112, second paragraph rejection at this time.

Claim 244 was rejected under 35 U.S.C. § 112 for being indefinite. Particularly, the term "unrelated" is alleged to be indefinite. Applicant respectfully traverses. The standard for indefiniteness is set forth above.

As noted above, just because a claim term is not defined in the specification does not mean that the claim term is indefinite if the meaning of the claim is discernable. Applying the broadest reasonable interpretation to the plain meaning of term shows exactly what was intended by the claim term. One of ordinary skill in the art would readily understand the meaning of the term, even if they had to consult a dictionary to establish the plain meaning. Since the claim is not indefinite, Applicant requests withdrawal of the § 112, second paragraph rejection at this time.

New claims 247 and 248 correspond to claims 229 and 238 but with language more directly from the specification. These claims further clarify that the provider of the supplemental data is distinct from the broadcaster.

35 U.S.C. § 103 - Abecassis

Claims 229, 230, 232-236, 238, and 239 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,192,340 to Abecassis (hereinafter “Abecassis”). Applicant respectfully traverses. For the Patent Office to prove *prima facie* obviousness, the Patent Office must show, by substantial evidence, all of the elements of the claim. MPEP § 2143.03. Furthermore, the Patent Office must also provide a reason to combine the elements. *KSR Int'l co. v. Teleflex Inc*, 550 U.S.398 (2007). This reason must come from the content of the prior art, and thus is also a factual finding that requires substantial evidence. *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693 (Fed. Cir. 2001). “[D]eficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense,’” nor may the Board simply reach conclusions based on its own understanding or experience. *In re Zurko*, 258 F.3d at 1385.

In its analysis of the first element of the claims 229 and 238 the Patent Office indicates that Abecassis teaches sending to a second information provider a broadcast schedule information. However, the Patent Office admits that this sending is not done by the broadcaster party as recited in the claim (see paragraph 18 of the Office Action of 26 June 2010). The Patent Office attempts to argue over this deficiency by stating that under *KSR* it would be obvious to have the broadcaster perform this function since it is allegedly one of a finite number of identified, predictable solutions. This assertion is not supported by evidence as required by *Zurko* and the APA. Nothing in Abecassis identifies the possibility of the broadcaster sending the schedule to the information provider. Therefore, the alleged solution is not identified as required under the *KSR* analysis. Furthermore, this modification makes Abecassis unsuitable for its intended purpose. In Abecassis, the end user (e.g., the person listening to the broadcast) makes the decisions about information and scheduling preferences (Abecassis, col. 17, lines 37-41) and provides these preferences to the information provider. The information provider searches out and prepares this information according to the dictates of the end user. This

arrangement is the only identified solution within Abecassis. Anything else is impermissible hindsight reconstruction on the part of the Patent Office.

The Patent Office further alleges that Abecassis inherently teaches sending broadcast schedule information. Applicant traverses. Abecassis states explicitly what is sent by the listener to the information provider – “information and scheduling preferences”. Information and scheduling preferences does not necessarily require the sending of broadcast schedule information as recited in the claims. That is, the listener could generally request hard rock and sports in the afternoon, traffic and news in the morning and polka and stock reports in the evening. Such a generalized request would not be schedule information as recited in the claims. To this extent, the reference fails to teach another element recited in the claims. Since the reference fails to teach or suggest the element, the Patent Office has not shown the element by substantial evidence.

For these reasons, the Patent Office has not established *prima facie* obviousness and independent claims 229 and 238 are allowable. Dependent claims 230, 232-236 and 239 depend from allowable claims 229 and 238 and are allowable at least for the same reasons.

Claim 233 recites that the broadcast content is sent in analog format and the supplemental information in a digital format. This claim element is alleged to be taught by the citations provided in reference to claims 229 and 238, however, a review of the citations does not show this claim element. This provides an independent reason why this claim is allowable over the references of record.

35 U.S.C. § 103 – Abecassis and Kumar

Claims 231, 237, and 240-246 were rejected under 35 U.S.C. § 103 as being unpatentable over Abecassis in view of U.S. Patent No. 5,949,796 to Kumar (hereinafter “Kumar”). Applicant respectfully traverses. The standard for establishing obviousness is set forth above. Furthermore, the reason to combine the references must come from the content of the prior art, and thus is the sort of factual finding that requires substantial evidence. *Zurko*.

Claim 240 and 246 recite sending information from a broadcaster to the information provider. The Patent Office provides no new analysis on this claim element. As explained

above, Abecassis does not teach this element and the analysis provided under the cover of *KSR* remains deficient.

Claims 240 and 246 further recite that the broadcast schedule information identifies when broadcast data is to be transmitted over specific broadcast channels at predetermined times. As discussed above, Abecassis does not inherently teach this element, because Abecassis does not necessarily require the listener to provide such specific information. Thus, Abecassis does not teach this claim element.

Applicant further traverses the reason the Patent Office advances in combining the references. Specifically, the Patent Office states that known elements are being combined according to known methods to yield predictable results. This asserted reason to combine the references lacks the requisite substantial evidence necessary to comply with *Zurko* and the APA. As such, the reasoning is deficient. Since the reasoning is deficient, it is improper to combine the references. Since the references alone admittedly do not establish obviousness, and the combination is not proper, the Patent Office has not established obviousness.

For at least these reasons, independent claims 240 and 246 are allowable. Dependent claims 231, 237 and 241-245 depend from allowable claims and are allowable at least for the same reasons.

New claims

New claims 247 and 248 further highlight that the three parties are separate and distinct. Support for this can be found in Figures 1-6 and the accompanying description. In contrast, Abecassis only teaches two distinct parties – the information provider and the listener. Likewise, new claim 249 recites that “the broadcast schedule comprising data identifying content and times content will be broadcast by the broadcaster. . . .” This specific sort of information within the schedule is not taught or suggested or inherent within Abecassis.

Interview Request

Applicant concurrently submits an interview request form requesting an interview for Tuesday September 28 at 2 PM. If this is not an acceptable time, then Applicant requests October 5 or 12 at the same time. If none of these dates works, Applicant requests that the Examiner telephone the undersigned so that a mutually acceptable date may be found. The

purpose of the interview is to discuss the distinction between the three party arrangement of the disclosure and the two party arrangement of Abecassis and to see if there is language which captures this distinction which defines over the references of record.

Conclusion

At least for the foregoing reasons, it is submitted that all claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Taylor M. Davenport at telephone number 203-832-2389 or via electronic mail at tdavenport@dloip.com, at the Examiner's convenience.

Respectfully submitted,

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Date

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